

REMARKS

Summary of the Office Action

The disclosure is objected to because of informalities.

Claims 6, 7, and 10-12 are objected to because of informalities.

Claims 1 and 2 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,766,124 to *Taguchi et al.* (“*Taguchi*”).

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Taguchi* in view of U.S. Patent No. 6,895,204 to *Shin*.

Claims 6-8, 10-12, and 15-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taguchi* in view of U.S. Patent No. 6,853,825 to *Suzuki et al.* (“*Suzuki*”).

Summary of the Response to the Office Action

The disclosure has been amended in accordance with the Examiner’s comments.

Applicants propose amending claims 1, 6-8, and 10-12. Claims 3, 5, 9, and 13-30 have been withdrawn. Accordingly, claims 1, 2, 4, 6, 7, 8, and 10-12 are pending for further consideration.

Objection to the Specification

The disclosure is objected to because of informalities. The Specification was corrected in accordance with the Examiner’s comments.

Claim Informalities

Claims 6-7 and 10-12 are objected to because of informalities. Informalities in claims 7 have been corrected. The objection to these claims under 37 CFR § 1.75(a) is respectfully traversed. Applicants respectfully submit that these claims, as amended, are in condition for allowance.

All Subject Matter Complies with 35 U.S.C. § 102(e)

Claims 1 and 2 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Taguchi*.

Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that the Office Action has not established that *Taguchi* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(e) should be withdrawn. Namely, Applicants contend that newly amended independent claim 1 recites the feature of "a developing device which has a developing roll that is opposite the image carrier, and rotates while carrying a toner on the surface thereof and that conveys the toner to a developing position at which the electrostatic latent image on the image carrier is developed by the toner." Emphasis added. At least this feature is not disclosed or taught by *Taguchi*.

Taguchi discloses an image forming device. See Abstract of *Taguchi*. However, *Taguchi* fails to teach or suggest at least the above recited features of claim 1.

As pointed out in MPEP § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). Therefore, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because *Taguchi* does not teach or suggest each feature of independent claim 1.

Additionally, Applicants respectfully submit that dependent claim 2 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

All Subject Matter Complies with 35 U.S.C. § 103(a)

Claim 4 stands rejected under 35 U.S.C. §103(a) as being unpatentable over *Taguchi* in view of *Shin*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that dependent claim 4 includes the features of independent claim 1 including “a developing device which has a developing roll that is opposite the image carrier.” Emphasis added. At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Taguchi* or *Shin*.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Third, the Office Action has not established a *prima facie* case of obviousness at least because neither *Taguchi* nor *Shin*, whether alone or in combination, teach or suggest all the recited features of newly amended independent claim 1. Namely, neither *Taguchi* nor *Shin* teach or suggest at least “a developing device which has a developing roll that is opposite the image carrier,” features recited in claim 1. That is, *Shin* does not make up for the deficiencies of *Taguchi*.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully

request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Taguchi* and *Shin* do not teach or suggest each and every feature of newly amended independent claim 1.

Additionally, Applicants respectfully submit that dependent claim 4 is also allowable insofar as it recites the patentable combinations of features recited in claim 1, as well as reciting additional features that further distinguish over the applied prior art.

Claims 6-8, 10-12, and 15-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Taguchi* in view of *Suzuki*. Applicants respectfully traverse the rejection for the following reasons.

Applicants respectfully submit that newly amended independent claims 6-8 includes the features of “a conveying path along which the transfer material passes through the secondary transfer position and the fixing position and which has a partial conveying path extending approximately vertically between the secondary transfer position and the fixing position.” At least these features are absent from, and are neither disclosed nor taught, alone or in combination, by either *Taguchi* or *Suzuki*.

To establish a *prima facie* case of obviousness, three basic criteria must be met (see MPEP §§ 2142-2143). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill the art, to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references must teach or suggest all the claim limitations.

Suzuki discloses an image forming apparatus with a conveying path passing through the secondary transfer position and the fixing position extending horizontally. See Fig. 3 of *Suzuki*. However, *Suzuki* fails to teach or suggest at least the above feature of newly amended independent claims 6-7.

Further, as recited in claims 6 and 7 of the present invention, the secondary transfer position (112) is disposed upstream in a transfer material conveying direction from a horizontal line (E) that passes through the center of rotation of the image carrier (101, which line (E) is approximately orthogonal to a direction in which the partial conveying path extends. See Fig. 17 of the specification. On the contrary, the secondary transfer position (39) of *Taguchi* is not disposed upstream in a transfer material conveying direction from an imaginary horizontal line that passes through the center of rotation of the image carrier (11), which line is approximately orthogonal to a direction in which the partial conveying path extends. See Fig.1 of *Taguchi*. As apparent from Fig. 1 of *Taguchi*, the secondary transfer position (30) is disposed on or above such straight line and, therefore, is disposed downstream from the straight line in the transfer material conveying direction.

As recited in claim 8 of the present invention, the circumference of the image carrier (101) of *Taguchi* is disposed downstream, in a transfer material conveying direction, from a first straight line (H) that is horizontal and approximately vertical to a direction in which the partial conveying path extends, the line is in contact with a portion (a portion touching the roll 122) of the intermediate transfer member on the most upstream side thereof in the transfer material conveying direction. See Fig. 17 of the specification. On the contrary, the circumference of the image carrier (11) of *Taguchi* is not disposed downstream, in a transfer material conveying direction, from an imaginary straight line that is horizontal and approximately vertical to a direction to which the partial conveying path extends, which line is in contact with a portion (a portion touching a roll opposite the roll 35) of the intermediate transfer member on the most upstream side thereof in the transfer material conveying direction, See Fig. 1 of *Taguchi*.

The Office Action has not established a *prima facie* case of obviousness at least because neither *Taguchi* nor *Suzuki*, whether alone or in combination, teach or suggest all the recited features of newly amended independent claims 6-8.

As pointed out in M.P.E.P. § 2143.03, “[t]o establish prima facie obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art”. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). As such, Applicants respectfully assert that the third prong of *prima facie* obviousness has not been met. Therefore, Applicants respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because *Taguchi* and *Suzuki* do not teach or suggest each and every feature of independent claims 6-8.

Applicants also respectfully request that the rejection under 35 U.S.C. § 103(a) should be withdrawn because claims 15-19 have been withdrawn.

Additionally, Applicants respectfully submit that dependent claims 10-12 are also allowable insofar as they recite the patentable combinations of features recited in claim 8, as well as reciting additional features that further distinguish over the applied prior art.

CONCLUSION

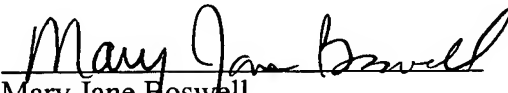
In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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